

REMARKS

The present amendment is filed in reply to the Office Action that was mailed on March 10, 2005. Claims 1-6 remain pending in the application. Claim 1 is amended herein to simply insert a comma “,” before the word “which” at line 7 to thereby make claim 1 more grammatically correct. No new matter is introduced by this Amendment and proper consideration of the same at present is required. It is noted that 37 CFR § 1.116 specifically allows the admitting of amendments such as the amendment to claim 1, which simply presents a rejected claims in better form for consideration on appeal.

Status of Claim 6

Claims 1-6 are pending in the application. In the cover sheet to the office action, the Examiner indicates that claims 1-6 are pending in the application and that claims 1-6 are rejected. However, in the body of the office action the Examiner does not set forth a rejection of claim 6. Clarification as to the status of claim 6 is respectfully requested.

37 CFR 1.132 Declaration

Enclosed herewith is a 37 CFR § 1.132 declaration of Mr. Satoshi Yoshida one of the instant inventors. Mr. Yoshida's declaration contains testing results that are submitted to be pertinent to a consideration of the patentability of the present invention over the cited art of record. Accordingly, the Examiner is respectfully requested to review Mr. Yoshida's declaration at this time. In Mr. Yoshida's declaration he refers to a graph of data that is attached thereto and at pages 4-5 of the declaration declares as follows:

Thus, using data from the best mode of the present invention (Example 1 in the instant application) and by graphing expected temperature viscosity curves to reflect expected corresponding viscosity values at 163° C, one of ordinary skill in the art would expect the melt viscosity of Example 12 of Alper et al. US 5,149,494 is fully outside the expected melt viscosity range of Example 1 in the present invention as well as the claimed range of 30 Pa·s at 140° C to 100 Pa·s at 140° C (*see claim 1*). As such, no overlap occurs between Example 12 of Alper et al. US 5,149,494, and no motivation is provided by Alper et al. that would allow one to arrive at the viscosity range recited in the pending claims (*see claim 1*)....

It is also noted that the attached graph contains reported data for Examples 3 and 6 of Alper et al. US 5,149,494, which were 10,260 cP and 10,363 cP at 325° F, respectively, which equates to 10.26 Pa·s at 163° C and 10.36 Pa·s at 163° C, respectively, and which are also shown in the attached graph to be outside expected viscosity values for the range of 30 Pa·s at 140° C to 100 Pa·s at 140° C if measured at 163° C.

As indicated previously (*see 5. above*), at column 17 of Alper et al. US 5,149,494 the same discloses that "...the adhesive formulation, in accordance with the teachings of Puletti et al. (Example 12) had an unacceptably high viscosity and further could not be tested because the viscosity prevented it from being coated in the manner called for in the tests which were described earlier."

Based on such teachings in the Alper et al. US 5,149,494 patent, I submitted that the same actually teaches those of ordinary skill in the art away from using its Example 12, and provides no motivation for those of ordinary skill in the art to utilize the same as a hot-melt adhesive in the formation of a diaper as instantly recited in pending claim 1, or any of the other remaining claims 2-6 under consideration at present....

Based on the temperature viscosity curves shown in the attached graph, one of ordinary skill in the art would realize that Example 12 of Alper et al. US 5,149,494 possesses a viscosity that falls outside the present invention as claimed. This fact when combined teachings at column 17 of the same Alper et al. patent that its example 12 was unacceptable, fails to motivate those of ordinary skill in the art to arrive at the instant invention as claimed.

Claim Rejection 35 USC § 103(a)

Claims 1-5 were rejected under 35 USC § 103(a) as being unpatentable over Alper et al. US '741 (US 5,149,741) in view of Fries, et al. US '592 (US 5,549,592). Applicants respectfully traverse the rejection and ask for reconsideration and withdraw of the same based on the following considerations.

Legal Standard for Determining Obviousness

To reach a proper determination under 35 USC § 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The

level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Present Invention Being Claimed

The invention defined by pending claims 1-6 in the application requires that the materials of the tape tab, side flap and hot-melt adhesive be chosen such that the side flap is torn near a joint when pulled at a peel angle of 180° at a speed of 100 m/min. Thus, the tape tab must be made of a

material that is more resistant to tearing than the side flap, while the adhesive must provide a strong enough bond so that the side flap tears before the entire adhesive seal is broken, with the adhesive being a hot-melt adhesive having a melt viscosity of 30 to 100 Pa·s at 140°C .

Distinctions Over the Cited Art of Record

The melt viscosities of the hot melt adhesives used in present invention do not overlap with the melt viscosities of the hot melt adhesives taught in the Alper et al. US '741 reference. In this regard, the Examiner is requested to review Mr. Yoshida's accompanying 37 CFR § 1.132 declaration at this time. As argued previously, the hot melt viscosity limitations of the present invention are not arbitrary. As pointed out in lines 16-28 on page 5 of the specification, hot melt adhesives having conventional viscosities are deficient with respect to providing both good shear resistance characteristics and peeling strength characteristics at the same time. In contrast, an important facet of the present invention is that the use of the hot melt adhesives prescribed by the claims in the diaper arrangement described by the claims, which hot melt adhesives provide ***both*** good shear resistance characteristics and good peeling strength characteristics ***at the same time***.

As shown in the attached declaration of Mr. Yoshida, it is clear that based on the teachings of the Alper et al. US '741 reference (e.g., its Example 12 and disclosure at column 17, lines 37-44), one of ordinary skill in the art would in no way be motivated to arrive at the instant invention as claimed including the hot melt adhesives used therein. The cited secondary reference of Fries et al. US '592 does not cure this deficiency.

According to MPEP § 2143.03, a *prima facie* case of obviousness cannot be said to exist unless the cited references teach or fairly suggest all claim limitations. Thus, since Alper et al. '741 and Fries et al. US '592 do not teach or suggest (among other things) the hot melt viscosity aspect of

Applicants' invention, a *prima facie* case of obviousness cannot be said to exist with respect to any of the instantly pending claims 1-6, wherein claims 2-6 all ultimately depend from claim 1. Accordingly, withdrawal of the outstanding rejection of record is respectfully requested.

Claims 3-6 are further distinguished over Alper and Fries by their recitation of "a hot-melt adhesive applied at a spread of 20 to 100 g/m²." As discussed in lines 4-7 on page 7 of the specification, spreading the particular hot melt adhesives required by the present invention at this rate provides a product that satisfies both the requirement for shear resistance characteristics and the requirement for peel strength characteristics and that also resists oozing out during storage. Neither reference of record is seen to suggest this aspect of Applicants' invention. Again, withdrawal of the rejection of record is solicited.

Conclusion

In view of the above amendments and comments, as well as the accompanying declaration of Mr. Yoshida, Applicants respectfully submit that pending claims 1-6 are now in condition for allowance. A Notice to such effect is earnestly solicited.

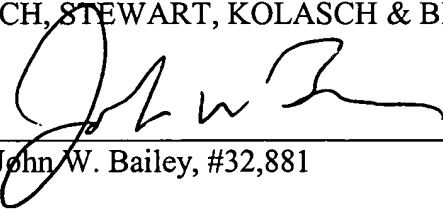
Should there be any outstanding issues to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number of the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


John W. Bailey, #32,881

JWB/jwb
0445-0320P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Enclosure: 37 CFR § 1.132 Declaration of Mr. Satoshi Yoshida